

12 JUL 2005



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FULBRIGHT AND JAWORSKI LLP
555 S. FLOWER STREET, 41ST FLOOR
LOS ANGELES CA 90071

In re Application of
SHINOTSUKA et al.
Application No.: 10/609,493
Filing Date: 24 June 2003
Attorney's Docket No.: 7272-119/10307292
For: IMAGE PROCESSING DEVICE

DECISION ON
PETITION
37 CFR 1. 182

This is a decision in response to applicant's "Petition under 37 CFR 1.182 to Accept Substitute Translation of PCT Claims" filed in the United States Patent and Trademark Office (USPTO) on 02 May 2005. The petition requests that the English translation of the PCT claims be accepted.

BACKGROUND

On 09 November 2001, applicant filed international application PCT/JP01/09820, which claimed priority of an earlier Japanese application filed 26 December 2000.

On 24 June 2003, applicant filed a utility transmittal letter filing the international application in United States as a utility patent application under 37 CFR 1.53(b). The transmittal letter was accompanied by, *inter alia*, the utility filing fee of \$750. The transmittal letter did not expressly request commencement of the national procedures under 35 U.S.C. 371(f).

On 02 May 2005, applicant filed the present petition, requesting that the USPTO "accept a substitute English translation of the original Japanese PCT claims for the set of English language claims filed with this U.S. National Phase application on June 24, 2003."

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). *See* the official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)". 37 CFR 1.495(g) states, in pertinent part:

The documents and fees submitted...must be clearly identified as a submission to enter the national stage under 37 CFR 371. Otherwise the submission will be considered as being made under 35 U.S.C. 111(a).

Furthermore, section 1893.03(a) of the MPEP states the following:

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form

PTO-1390) as the transmittal letter.....

[I]f there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

A review of the application file reveals that applicant did not use Form PTO-1390 as a transmittal letter. In fact, the transmittal letter filed on 24 June 2003 indicated the filing as "a utility patent application.... under 37 CFR 1.53(b)". Applicant's reference to 37 CFR 1.53(b) in the transmittal letter is inconsistent with and would have contradicted any desire expressed in any papers filed to enter the national stage of the PCT under 35 U.S.C. 371. Application papers submitted under 37 CFR 1.53(b) are considered filed under 35 U.S.C. 111(a).

Since applicant's transmittal letter referenced 37 CFR 1.53(b), the application was properly treated as an application under 35 U.S.C. 111(a). (See 37 CFR 1.495(g)). The transmittal letter authorized applicant's deposit account to be charged in the amount of \$750, the filing fee for a utility application under 35 U.S.C. 111(a). Accordingly, the filed application was properly treated as a filing under 35 U.S.C. 111(a).

In light of the above discussion, and applicant's intention to file the substitute English translation of PCT claims to fulfill the national stage entry requirements pursuant to 35 U.S.C. 371(c)(2) and 37 CFR 1.495(c), the English translation of the PCT claims filed on 02 May 2005 will not be entered. The new set of claims 1-12 filed on 24 June 2003 will be examined in due course.

CONCLUSION

Applicant's submission on 24 June 2003 was properly treated as an application filed under 35 U.S.C. 111(a), with a filing date of 24 June 2003. Applicant's petition under 37 CFR 1.182 to accept substitute translation of PCT claims as a filing under 35 U.S.C. 371 is **DISMISSED without prejudice.**

This application is being returned to Art Unit 2625 for examination of claims 1-12 filed on 24 June 2003 in due course.



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571)272-3286